THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte ROBERT D. DANNENBERG

_____

Appeal No. 95-3673
Application 07/935,762[1]

_____

HEARD: December 11, 1997

_____

Before THOMAS, JERRY SMITH and TORCZON, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

[1] Application for patent filed August 26, 1992.

Appellant has appealed to the Board from the examiner's final rejection of claims 1 to 22, which constitute all the claims in the application.

The following references are relied on by the examiner:

Bruggemann	4,701,867	Oct. 20, 1987
Burke et al. (Burke)	4,803,646	Feb. 07, 1989

Claims 1 to 22 stand rejected under the second paragraph of 35 U.S.C. § 112 as being vague and indefinite. Claims 1 to 22 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Bruggemann as to claims 1 to 8, with the addition of Burke as to claims 9 to 22.

Rather than repeat the positions of the appellant and the examiner, reference is made to the briefs and the answer for the respective details thereof.

OPINION

Turning first to the rejection of claims 1 to 22 under the second paragraph of 35 U.S.C. § 112, it is to be noted that to comply with the requirements of the cited paragraph, a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure and the teachings of the prior art as it would be by the artisan. Note In re Johnson, 558 F.2d 1008, 1016, 194 USPQ

187, 194 (CCPA 1977); In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

We have reviewed and considered the examiner's reasons in support of the rejection, but are not convinced that the cited claims fail to comply with the second paragraph of 35 U.S.C. § 112. We are in general agreement with the positions advocated by appellant between pages 9 and 13 of the principal Brief on appeal.

The use of various forms of the word "comprise" does not render the claims indefinite, but merely indicates to the reader that other elements other than those recited may be included in the combination. The conventional meaning of this term is that it is open-ended. The use of the words "characterized in that" in each independent claim on appeal clearly indicates to the reader that the previously recited self-test means is further recited in greater detail in the language following the questioned language of "characterized in that." As to certain dependent claims, although we recognize that "the first-mentioned particular self-test" is not explicitly previously recited in claims before exemplary claim 5, for example, there is in independent claim 1 clearly recited "a particular self test." The second paragraph of 35 U.S.C. § 112 does not require the use

of the exact same language for an antecedent basis to be clear to the artisan. The use of the pronoun "itself" clearly in a normal grammatical sense refers back to the structural recitation of the electronic circuit means. Thus, from an artisan's perspective all of the claims on appeal recite the claimed invention with a reasonable degree of precision and particularity, when read in light of the disclosure and the teachings of the prior art as it would be by the artisan.

As such, we reverse the rejection of claims 1 to 22 under the second paragraph of 35 U.S.C. § 112.

Turning lastly to the rejection of all claims on appeal under 35 U.S.C. § 103, we reverse the two recited rejections on this statutory basis. Initially, we consider the obviousness of claim 1 in light of the teachings and suggestions of Bruggemann alone.

At the outset, we see no patentable distinction within 35 U.S.C. § 103 by the mere use of the recitation in each independent claim on appeal of an electromechanical meter movement operating a pointer against a scale of values. Such are

conventional in the art as recognized by Bruggemann anyway in the discussion beginning at column 1, line 17.

There, it was conventional in the art to test such electro-mechanical/analogue-display instruments per se by the use of a simulated measured value and determining whether the

corresponding displayed value was obtained. This, by necessity, required a sweeping action of the type claimed to have been instituted.

On the other hand, the bulk of the disclosure in Bruggemann is not concerned with such types of displays but only segmented types of displays comprised of liquid crystals. A significant portion of the details of Bruggemann's disclosure relates to testing each of the individual segments of the liquid crystal displays represented by various display elements 1 to 7 in Figure 1 by means of the testing action depicted in Figures 3b through 3d. Another portion of the testing action in Bruggemann is related to testing certain functional elements or operational elements of circuitry therein as depicted by the numeric representation only shown in Figure 3a. See for example the discussion beginning at the bottom of column 5 and numeric

representations indicated there to signify various status conditions of that which has been tested.

Bruggemann's pertinent disclosure as it relates to the claimed invention relates to a sweeping-type action discussed generally and initially at column 3, lines 7 through 33. In a manner that appears to be analogous to the methodology used to test prior art analogue display pointer-type instruments discussed in our earlier referenced column 1 location of Bruggemann, this column 3 portion of Bruggemann's summary of the invention indicates a corresponding methodology to test the odometer and tachometer shown in Figure 1. This forms a part of the final-test phase of the various phases discussed in Bruggemann and is characterized as corresponding to a normal operating mode. It explicitly indicates at column 3, lines 15 through 18 that "the display indicia for the rpm display move up in the manner of a bar graph and show odometer increments." The corresponding detailed description of the disclosure of this methodology is presented at column 5, lines 15 through 36 and column 6, lines 9 through 25.

In each of these locations of Bruggemann it appears that there is no repetitive action of testing the segmented displays of liquid crystal displays in a manner required at the end of representative claim 1 on appeal. It appears to us that the intent of the very last portion of the final test phase is to test each of the speedometer, odometer and rpm meter once only. Column 6, lines 20 through 25. There is no positive teaching and certainly no suggestion that this portion of the testing action within Bruggemann would be repeated in any manner let alone repeated in a manner corresponding to a particular self test as required at the end of representative independent claim 1 on appeal.

Furthermore, and significantly to us, this claim requires that the testing represented by the sweeping action of the mechanical meter movement claimed is to represent the testing result of other recited elements, namely, the recited electronic circuit means. Bruggemann’s teachings as to the noted feature identified at 3 locations in Bruggemann and earlier by us in this opinion only relate to testing the respective speedometer,

odometer and rpm meter per se and not of any other circuit elements of Figure 1 of this reference. This entire testing action of this reference requires the use of the special final test mode device depicted in Figure 2. Thus, the testing action here is not intended to test, for example, by the scanning action of the respectively identified 3 displays, the analogue-to-digital converter 14 in Figure 1, whose test mode has been identified in a different portion of this reference to be tested in a manner by representing only a numeric output as discussed at column 5, lines 52 through 64.

We do not agree with the examiner's belief that the blinking action indicated as an alternative display approach at column 2, lines 37 through 42, of Bruggemann would have indicated to the user or artisan a corresponding sweeping action of the type recited in each independent claim on appeal.

As to independent claim 13, we recognize that there is no repetitive sweeping action of the meter required by this claim. However, it is noted that the compare operations of Bruggemann are not taught to exist in the context of a plain sweeping action-type of display as required by independent claim 13 on appeal. As to independent claim 21, Bruggemann's teachings do

indicate a distinction between a fault and no fault situation, but not in the context of any sweeping action as discussed earlier. As to these latter two independent claims, the additional teachings of Burke add nothing to cure the noted deficiencies of Bruggemann. Overall then, the art rejection of each independent claim 1, 13 and 21 and their respective dependent claims under 35 U.S.C. § 103 cannot be sustained.

In view of the foregoing, the decision of the examiner rejecting claims 1 to 22 under the second paragraph of 35 U.S.C. § 112 and under 35 U.S.C. § 103 are reversed.

REVERSED

)

Appeal No. 95-3673
Application 07/935,762

JAMES D. THOMAS Administrative Patent Judge	)	
JERRY SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
RICHARD TORCZON Administrative Patent Judge	)	

Dennis K. Sullivan
NAVISTAR INTERNATIONAL
TRANSPORTATION CORPORATION
455 North Cityfront Plaza Drive
Chicago, IL 60611